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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,401	03/15/2004	Jehan Clements	02013-06034s	1672
27171 7590 09/14/2009 MILBANK, TWEED, HADLEY & MCCLOY 1 CHASE MANHATTAN PLAZA NEW YORK, NY 10005-1413				
EXAMINER GISHNOCK, NIKOLAI A				
ART UNIT		PAPER NUMBER		
3715				
MAIL DATE		DELIVERY MODE		
09/14/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 10/801,401	<b>Applicant(s)</b> CLEMENTS, JEHAN
<b>Examiner</b> NIKOLAI A. GISHNOCK	<b>Art Unit</b> 3715

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 18 August 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 30 July 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 21-24, 26-29 and 31-34.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/XUAN M. THAI/  
Supervisory Patent Examiner, Art Unit 3715

Continuation of 11, does NOT place the application in condition for allowance because: Claims 21-24 & 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales (US 2002/0161603 A1 ), hereinafter known as Gonzales, and further in view of Sococca (US 6,126,202 A), hereinafter known as Sococca, Clements (US 6,210,172 B2), hereinafter known as Clements '172, and Schubert (US 5,127,879 A), hereinafter known as Schubert. Claims 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales, Sococca, Clements '172, and Schubert, as applied to claims 21 & 26 above, and further in view of Schach et al. (US 5,397,156 A), hereinafter known as Schach. Applicant's arguments have been considered but are not persuasive. In regards to Applicant's remarks that Gonzales teaches only publishing software, and fails to teach where the generated book is a story book, Examiner notes that Gonzales is not relied upon to teach the limitation. Instead, Sococca teaches this at Para. 0032-44. It would have been obvious to use a web publishing system such as Gonzales' to publish any type of book, including children's story books. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In response to Applicant's argument that Gonzales does not disclose "the first set of inputs," because an "article name or page name" is not "author information", an "article title" -- in the web page context - is the page (or "article"), not the title of the entire work; in the web-page context or any other, a string of text comprising author, title, or copyright information, etc. is merely non-functional printed matter, and having no tie in function to the substrate, is not patentably distinguished over the prior art. It would be obvious to merely provide the relevant publication data via HTML tags for a web-based publishing software such that it is printed in the traditional manner on the first inside leaf of the book. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,403-04 (Fed. Cir. 1983). USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See also *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004) and MPEP 2106.01. With regard to Applicant's arguments that Sococca fails to teach one or more indicia for indicating how to assemble the pages in diamictric contraposition, Clements '172 at (6:27-48) teaches: In order to create a storytelling book in accordance with the invention, a corresponding insertion page having a picture, and preferably some text as well, corresponding to the picture on the original insertion page is generated either manually or mechanically (e.g., using a photocopier or a graphical computer program). This step of generating a series of corresponding insertion pages having corresponding pictures and text is most preferably done by having the creator of the story write the text on a corresponding lined insertion page provided with the book. Most preferably, this lined corresponding insertion page has two columns of dotted lines with the instructions "Write your story using these lines" noted in parentheses at the top of the page. On this lined corresponding insertion page, a space without lines is provided in the lower right-hand corner with the instructions, "Paste a reduced size copy of your picture here" noted in the space. A reduced-size picture corresponding to the picture on the original insertion page may be created either manually or mechanically, and then pasted in the indicated space. Alternatively, the corresponding picture may be of any size, and may be considered the corresponding insertion page itself. Thus, the rejection under 35 USC §103 does not rely upon Sococca to teach this limitation, as Clements '172 teaches providing instructions for assembling the book pages in diamictric contraposition as indicia in the story book. Applicant's arguments further directed to Clements '172 are not persuasive. The courts have held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). Applicant arguments with regard to the Schubert reference are also not persuasive because one of ordinary skill in the art would clearly understand copyright information on the first leaf of a book to refer to the copyright date of the book, not of a software program used to generate the book. See applicant's Figure 2, Item 200; in this case, (c) 2004 Jehan Clements refers to the author of the story, not of the software used to generate the book. Applicant's arguments with regard to Schach are also irrelevant as Clements '172 is used to demonstrate a teaching of the page orientation being "in diamictric contraposition" (i.e., opposite to one another). See paragraph 6 above. The publishing templates of the system and method for of Gonzales would be used to produce the storybook, having an "a" set of pages including identical or closely corresponding graphics and illustrations as a "b" set, but not including the corresponding words or printed text, of Clements '172, in order to easily allow a user to specify, preview, and remotely produce the storybook document in volume, that is, the positioning of the pages would be merely determined in advance to facilitate printing. The content of the indicia of the pages is not a distinguishing basis for patentability. *Gulack*, *Id*. With regard to applicant's arguments that examiner has not made a prima facie case of patentability due to failure to provide adequate reasons to combine the cited references, see pages 16-19, applicant's emphasis added remarks highlight examiner's explicit and sufficient rationale for combining the references. In this case, one would want to combine improvements from Sococca, Clements, Schubert and Schach with the base invention of Gonzales in order to receive the well-known and expected benefits applicable to book publishing (e.g., proofing, preview, professional touches, hard covering). As such, examiner provides for A in view of B; A in view of X, and A in view of Y, etc. in terms of the recited limitations. As such, applicant has not proffered specifically where examiner's rationale is in error. The focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art, would have known at the time of the invention, and on what such a person would have been reasonably expected to have been able to do in view of that knowledge. This is so regardless of whether the source of that knowledge and ability was documentary prior art, general knowledge in the art, or common sense. See MPEP 2142 (Rev. 6, Sept. 2007). *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 698, 82 USPQ2d at 1385 (2007). For the above reasons, examiner's position is that a proper prima facie case of obviousness has been made in the above action.